PL4

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,129	11/07/2000	David N. Spiegel	END920000101US1	1094

7590   01/13/2004

ROANALD A. D'A;ESSANDRO
HOFFMAN, WARNICK & D'ALESSANDRO
THREE E-COMM SQUARE
ALBANY, NY 12207

EXAMINER
RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
2122	6

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/708,129	SPIEGEL, DAVID N.
	Examiner	**Art Unit**
	J. Derek Rutten	2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 November 2003</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☒ Claim(s) <u>6 and 14</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Remarks

1.   Applicant's amendment dated November 7, 2003, responding to the August 5, 2003

Office Action provided in the rejection of claims 1-18, wherein claims 6, 14, and 18 have been

amended. Claims 1-18 remain pending in the application and have been fully considered by the

examiner.

Applicant primarily arguing that the claims are not anticipated by the Stupek patent,

because Stupek fails to disclose the claimed "activating a maintenance application on said

computer system" and "entering a first list of third maintenance items in said maintenance

application" (See fifth paragraph on page 9 of the amendment and response), but is not

persuasive, as will be addressed under the "Prior Art's Arguments – Rejections" section at item 2

below. Accordingly, the rejection of the claims over the prior art in the previous Office Action is

maintained and **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Prior Art's Arguments – Rejections

2.   Applicant's arguments filed on November 7, 2003, in particular on pages 9 and 10, have

been fully considered but are not persuasive.

On page 9, fifth paragraph, Applicant contends that claim 1 is not anticipated by Stupek,

as Stupek fails to disclose the claimed "activating a maintenance application on said computer

system" and "entering a first list of third maintenance items in said maintenance application".

Regarding the claimed "activating a maintenance application on said computer system",

in the previous Office Action, paper number 3, the Examiner pointed to figure 1, item 11 of

Stupek in reference to the "Upgrade Advisor". The upgrade advisor is one component of

Stupek's maintenance system, and operates within Stupek's "Upgrade Device 10". Activation of

the upgrade advisor implies activation of the upgrade device. Further, the step of activating this

component is inherent in the operation of Stupek's system, since if it is not activated, the system

will not function. Further, Stupek discloses invoking, or *activating* the upgrade advisor (column

9 lines 48-49: "When the user invokes the upgrade advisor...").

Regarding the claimed "entering a first list of third maintenance items in said

maintenance application", Applicant argues on page 10 paragraph 1, that "The user in Stupek,

however, does not enter a first list of third maintenance items into the upgrade advisor 11 as set

forth in claim 1." It is noted that features upon which Applicant relies (i.e., "The user") are not

recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, Stupek discloses a user entering a list of

maintenance items in a maintenance application (column 4 lines 45-8: "When the upgrade

advisor 11 and/or **the user have selected** 100 the network resources 3 that need to be upgraded,

an upgrade installer 17 oversees the automatic installation of the packages to the server."). The

upgrade installer 17 forms part of the upgrade device 10 along with the upgrade advisor 11. The

list of network resources 3 are inherently entered into the maintenance application, otherwise the

upgrade installer would not be able to perform the installation.

Specification

3.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

The following title is suggested: Method, System, and Computer Program Product for

Software Maintenance with Automatic Dependency Resolution.

Claim Objections

4.   Claims 6 and 14 are objected to because of the following informalities: The phrase "is a

Service Link" contains a typo. This phrase should be reworded in the claims as --is a-Service

Link--. Appropriate correction is required.

Claim Rejections

5.   Claims 1-18 stand finally rejected, as claims 1, 3-9, and 11-18 being anticipated by

Stupek, and claims 2 and 10 being unpatentable over Stupek in view of Gowan. The claim

rejections from the previous Office Action of August, 5 2003, paper number 3, is reproduced

below for completeness.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 5,960,189 to Stupek et al.

Regarding claim 1, Stupek discloses

A method of maintaining software on a computer system comprising the steps of:

Bringing up first and second host sessions on a computer system (e.g. computer

environments for starting a software upgrade application);

Starting in said first host session, a software recording application having data

on first maintenance items applied to said computer system (figure 1 reference 5

"Management Information Base", column 3 lines 22-30, "A management information

base (MIB) within the server maintains basic descriptive information about each of the

resources available on the server."),

Starting in said second host session, a database application having a database of

second maintenance items including prerequisite items and corequisite items

corresponding to each of said second maintenance items (figure 1 reference 9 "Upgrade

Database", column 7 lines 8-10, "The database also contains information regarding the

dependencies between the package and other upgrade objects or packages...");

Activating a maintenance application on said computer system (figure 1 reference

11 "Upgrade Advisor");

Entering a first list of third maintenance items in said maintenance application

(figure 1 reference 7 "Resource Upgrades", column 3 lines 31-43, "Upgrades to the

network resources are provided to a server manager by a distribution medium...");

Searching said database for said prerequisite items and corequisite items

corresponding to each of said third maintenance items on said first list, and adding said

corresponding prerequisite items and corequisite items to said first list (column 4 lines

35-44, "An agent of the server manager located in the server uses this information to

search for the resource...the server manager creates entries for the resource in the server

database", where the server database keeps information about the Management

Information Base [MIB]);

Thereafter determining from said software recording application which items on

said first list have already been received, and adding those items not received to an order

list (column 4 lines 19-26, column 5 lines 41-47, "The upgrade advisor then retrieves

upgrade information from the upgrade database and performs two types of comparisons:

...b) whether or not the version number of the upgrade package matches the version

number of the corresponding network resource...").; *and*

Ordering, receiving, and applying said items on said order list (column 5 lines

48-63, "When the job is ready to be installed to the target server, the server upgrader

connects with the server...and then sends the job...to a staging area. The staging area

may...be anywhere else in the network capable of handling the deposit and retrieval of

upgrade files....the agent executes the instructions in the control file...").

Regarding claim 3, Stupek et al discloses the use of an operating system with the

computer system (column 1 line 17).

Regarding claim 4, Stupek et al discloses the use of a network with the computer system

(column 1 line 13).

Regarding claim 5, Stupek et al discloses the practice of keeping track of what software

has been installed or uninstalled (column 6 lines 45-47).

Regarding claim 6, Stupek et al disclose the use of a database application through the use

of the "server database" (column 4 lines 14-16).

Regarding claim 7, Stupek et al discloses the practice of storing information relating to

program updates in a file (column 6 lines 43-45).

Regarding claim 8, Stupek et al discloses the practice of updating software on the

computer system (column 5 lines 48-63).

Regarding claims 9, 17, and 18, they are product versions of the process claimed in claim

1 and are rejected for the reasons set forth in the rejection of claim 1.

Regarding claims 11-16, they are product versions of the process claimed in claims 3-8,

respectively, and are rejected for the reasons set forth in the above rejection of those claims.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stupek et

al as applied to claim 1 above, and further in view of "Y2K Compliance and the Distributed

Enterprise" by Gowan et al.

Regarding claim 2, Stupek et al teaches a system for software maintenance. Stupek does not specifically teach software maintenance on a mainframe. Gowan et al teaches the benefits of upgrading a mainframe computer system. It does not teach upgrading a mainframe using a software maintenance system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Stupek's software maintenance system with Gowan's concept of upgrading a mainframe computer in order to facilitate a swift and automated upgrade process. This is desirable since mainframe computers serve a large number of users, and having a swift and automated upgrade process ensures the availability of correct and efficient software.

Regarding claim 10, it is a system version of the process of claim 2, and is rejected for the reasons set forth in the rejection of claim 2 above.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
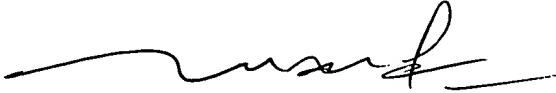
date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to J. Derek Rutten whose telephone number is (703) 605-5233.

The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703)306-5484.

jdr

TUAN DAM
SUPERVISORY PATENT EXAMINER